

REMARKS/ARGUMENTS

Status of the Claims

In the final Office Action mailed December 1, 2004, claims 1-21 are pending. Claims 1-21 were rejected. Claims 1, 8 and 15 were amended. This rejection is respectfully traversed. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein.

The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for all the reasons discussed herein); (b) do not raise any new issues requiring further search and /or consideration; and (c) place the application in better form for appeal (if necessary). No new issues are raised as the amendments merely clarify and/or correct the claims. Accordingly, entry is proper under 37 CFR §1.116.

Claim Rejections – 35. U.S.C. §102

The Examiner rejected claims 1-5, 8-12 and 15-19 under 35. U.S.C. §102 as being anticipated by U.S. Patent 5,530,373 to Gibson, *et al.* (hereinafter "Gibson"). In light of the following remarks, Applicants respectfully submit that these claims are allowable. Without conceding the propriety of the rejections, claims 1, 8 and 15 have been amended. Support for these amendments are to be found at least in paragraph 36 of the specification and in the Figures.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or implicitly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P, Gibson cannot be said to anticipate the present invention as recited in these claims. Accordingly, withdrawal of the rejection is respectfully requested.

It is respectfully submitted that Gibson does not teach or suggest, *inter alia*, “the module being a separate device from a device being tested and the module configured to provide additional capability to a separate portable electronic device,” as recited in claim 1.

Rather, Gibson is directed to a conventional stand alone electronic test instrument for acquiring and graphically displaying component test data. (Col. 1 lines 6-9). Gibson also has a digital multimeter function. (Col. 2, lines 51-55). The Office Action states that Gibson, “disclose[s] a digital multimeter adapter for a portable electronic device, comprising a module (device under test (DUT) 14 shown on FIG. 1) adapted to interface with a hardware interface port of a portable electronic device....” However, this is not the claimed invention. Gibson has a stand alone test instrument with its own display and processor and collects and represents data from a device under test. Thus, Gibson discloses a conventional DMM. Nowhere is there a mention of a module (separate from a device being tested) capable of providing another electronic device the ability to perform as a DMM. In contrast, the present application allows a user to use a portable electronic device he or she may already possess and give it the additional functionality of a DMM. This is beneficial when the device is not a DMM and a user does not have a DMM. Thus, the user need not purchase a separate DMM. The user only needs the module.

Moreover, Gibson's FIG. 1 is an illustration of an electronic test instrument 10 with probes 12 coupling the electronic test instrument 10 to a device under test (DUT) 14. (Col. 5, lines, 40-46 and FIG. 1). The instrument 10 receives signals, performs its functions and displays the signal. (Col. 5, lines 40-46). Thus, this system consists of only the DUT, probes and the instrument 10. The DUT of Gibson is equivalent to the "a device being tested," recited in Applicants' claims 1 and not the module as the Office Action states.

Therefore, Gibson does not teach or suggest, *inter alia*, "a module adapted to interface with a hardware interface port of a portable electronic device having a processor and a display, the module including a computer program memory, the module being a separate device from a device being tested and the module configured to provide additional capability to a separate portable electronic device," or, "a device being tested," as recited in new claim 1.

Claims 2-7 and 21 depend from independent claim 1. Therefore, claims 2-7 and 21 are patentable at least by reason of their dependency.

It is also respectfully submitted that Gibson does not teach or suggest, *inter alia*, the method described in claim 8, "changing the function of the electronic device with the module to have the electronic device perform as a digital multimeter," and, "collecting, using a plurality of leads connected to the electronic device, data representative of a signal from an external source separate from the module," as recited in claim 8 because Gibson is directed to a conventional stand alone electronic test instrument for acquiring and graphically displaying component test data, which performs as a digital multimeter. (Col. 1 lines 6-9; Col. 2, lines 51-55).

Claims 9-14 depend from independent claim 8. Therefore, claims 9-14 are patentable at least by reason of their dependency.

It is also respectfully submitted that Gibson does not teach or suggest, *inter alia*, “an external source separate and independent from the module,” as recited in claim 15 because nowhere is there a mention of a module (separate from a device being tested) capable of providing another electronic device the ability to perform as a DMM

Claims 16-20 depend from independent claim 15. Therefore, claims 16-20 are patentable at least by reason of their dependency. Accordingly, withdrawal of the rejection of these claims is respectfully requested.

Claim Rejections 35 U.S.C. §103(a)

Examiner rejected claims 6, 7, 13, 14, 20 and 21 under 35 U.S.C. §103(a) as being unpatentable over Gibson, *et al.* in view of U.S. Patent No. 5,508,607 to Gibson. Because these claims depend from the independent claims 1, 8 and 15, which are in condition for allowance, claims 6, 7, 13, 14, 20 and 21 are also in condition for allowance. Withdrawal of the rejection is respectfully requested.

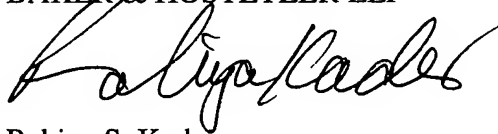
CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that this application is in condition for allowance. Should the Examiner believe that anything further is necessary to place the application in even better condition for allowance, the Examiner is invited to contact the undersigned attorney at 202-861-1746 in an effort to resolve any matter still outstanding before issuing another action.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to our Docket No. 87354.2801.

Respectfully submitted,

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Date: May 2, 2005
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